

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.	§	
	§	
Plaintiffs,	§	CIVIL ACTION NO. 6:12-cv-462
	§	(Consolidated Lead Case)
v.	§	
DISTINCTIVE DEVELOPMENTS LTD.,	§	
	§	
Defendant.	§	

JOINT MOTION TO STAY PENDING *INTER PARTES* REVIEW

Plaintiffs Uniloc USA, Inc. and Uniloc Luxembourg S.A. (collectively, “Uniloc”) and Defendants Distinctive Developments Ltd., Electronic Arts Inc., Gameloft S.E., Halfbrick Studios Pty Ltd., Laminar Research, LLC, Mojang AB, and Square Enix, Inc. hereby submit this joint motion to stay pending the outcome of an *Inter Partes* Review (“IPR”) of Uniloc’s United States Patent No. 6,857,067 (“the ‘067 patent”) by the United States Patent and Trademark Office (“PTO”).

Uniloc filed suit against Defendants on July 20, 2012. The Court consolidated the various actions on February 1, 2013. *See* Dkt. No. 43. A *Markman* hearing is scheduled for January 30, 2014 and Trial has been set for May 11, 2015.

On June 28, 2013, Defendants filed a petition for *Inter Partes* Review concerning certain claims of the ‘067 patent, including claim 107, which has been asserted in this case. The IPR petition relies on United States Patent No. 7,032,240 (“Cronce”), 5,910,987 (“Ginter”), 6,008,737 (“Deluca”) and 7,036,011 (“Grimes”) in alleging that certain claims of the ‘067 patent are invalid. *See* Exh. A (“IPR Petition”) at pp. 2-3. The IPR references constitute four of the

nine patent and prior publication references in Defendants' Invalidity Contentions. See Exh. B. (Defendants' Invalidity Contentions) at pp. 3-4.

The Parties have conferred and agree that a stay is appropriate because it will simplify the issues in question and trial of the case and will not unduly prejudice any party to this matter. Specifically, if the PTO grants the petition and the '067 patent survives, Defendants' prior art references will be subject to statutory estoppel and will be eliminated from the case. *See* 35 U.S.C. § 315(e)(2). Alternatively, if the asserted claim in this case is deemed invalid, the present litigation becomes moot. Furthermore, *Inter Partes* Review decisions are required to be "be issued not later than 1 year after the date on which the Director notices the institution of a review..." 35 U.S.C. § 316(a)(11).¹ Given that trial is not scheduled until May 2015, the Parties believe it would be an inefficient use of the Court's and Parties' resources to proceed with discovery, *Markman*, etc.

Therefore, the Parties respectfully request that the Court stay the present matter pending disposition of the re-examination. Either party may request the Court lift the stay for good cause shown, and the burden to show good cause will be on the party moving to lift the stay.

Dated: July 17, 2013

/s/ Steven W. Hartsell
Barry J. Bumgardner
Lead Attorney
Texas State Bar No. 00793424
Steven W. Hartsell
Texas State Bar No. 24040199
Jaime K. Olin
Texas State Bar No. 24070363
NELSON BUMGARDNER CASTO, P.C.
3131 West 7th Street, Suite 300

Respectfully submitted,

/s/ Eric A. Buresh
Melissa R. Smith
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
(903) 934-8450
(903) 934-9257 – fax
Melissa@gillamsmith.com
Megan J. Redmond (pro hac vice)

¹ The Patent Office can "extend the 1-year period by not more than 6 months." 35 U.S.C. § 316(a)(11).

Fort Worth, Texas 76107
Phone: (817) 377-9111
Fax: (817) 377-3485
barry@nbclaw.net
shartsell@nbclaw.net
jolin@nbclaw.net

James L. Etheridge
Texas Bar No. 24059147
ETHERIDGE LAW GROUP, PLLC
2600 E. Southlake Blvd., Suite 120 / 324
Southlake, Texas 76092
Telephone: (817) 470-7249
Facsimile: (817) 887-5950
Jim@EtheridgeLaw.com

T. John Ward, Jr.
Texas State Bar No. 00794818
J. Wesley Hill
Texas State Bar No. 24032294
WARD & SMITH LAW FIRM
P.O. Box 1231
1127 Judson Road, Ste. 220
Longview, Texas 75606-1231
(903) 757-6400
(903) 757-2323 (fax)
jw@wsfirm.com

**ATTORNEYS FOR PLAINTIFFS UNILOC
USA, INC. AND UNILOC LUXEMBOURG
S.A.**

Eric A. Buresh (pro hac vice)
Caroline A. Bader (pro hac vice)
ERISE IP, P.A.
6201 College Blvd., Suite 300
Overland Park, Kansas 66211
(913) 777-5600
(913) 777-5601 – fax
megan.redmond@eriseip.com

**ATTORNEYS FOR DEFENDANTS
DISTINCTIVE DEVELOPMENTS LTD,
ELECTRONIC ARTS INC., GAMELOFT
S.E., HALFBRICK STUDIOS PTY. LTD.,
LAMINAR RESEARCH, LLC, MOJANG
AB, AND SQUARE ENIX, INC.**

CERTIFICATE OF SERVICE

I hereby certify that on the 17th day of July 2013, I electronically filed the foregoing document with the clerk of the court for the U.S. District Court, Eastern District of Texas, Tyler Division, using the electronic case filing system of the court. The electronic case filing system sent a “Notice of Electronic Filing” to the attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means.

/s/ Steven W. Hartsell